



In
2667

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
	:	Examiner: P.P. Jones
Raghavan MENON ET AL.)	
	:	Group Art Unit: 2667
Application No.: 09/994,592)	
	:	
Filed: November 27, 2001)	
	:	
For: APPARATUS AND METHOD)	
FOR A FAULT-TOLERANT	:	
SCALABLE SWITCH FABRIC)	
WITH QUALITY-OF-SERVICE	:	
(QOS) SUPPORT)	September 15, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This Response is filed in response to the Office Action dated August 16, 2005, which set forth a shortened statutory period for reply ending on September 16, 2005. It is believed that no extension fee is required in connection with this Response. However, if an extension fee is deemed required, please charge any such fee to Deposit Account 06-1205.

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The Office Action required restriction between the following Groups of claims:

1. Group I, claims 1-32 and 37-82, drawn to managing and configuring components associated with routing as associated in a switch fabric environment, classified in class 370, subclasses 364, 392, 394, 395, 390, 466 and 469; and

2. Group II, claims 33-36, drawn to managing the forwarding of data cells in a communication system that includes multiple cell framers, classified in class 714, subclasses 766 and 800.

Accordingly, Group I (Claims 1-32 and 37-82) is hereby elected for initial prosecution on the merits, subject to the below traversal of the restriction requirement.

The restriction requirement is respectfully traversed for the following reasons.

The Office Action asserts that Groups I and II are related as combination and subcombination and are distinct, and cites MPEP 806.05(c) (relating to combinations/subcombinations) as supporting authority. However, it is believed that the Office Action has mis-applied the test for determining whether there is a combination and subcombination which would justify a restriction requirement. First, MPEP § 806.05(a) states that “[a] combination is an organization of which a subcombination ... is a part.” Clearly, the apparatus coupled to plural cell framers, of Group II claims 33-36, cannot be a subcombination of any method, such as that recited in Group I claims 3-13, 15-19, 26, 27, 65-73, and 76-78. Neither is that apparatus understood to be also a subcombination of the apparatus recited in Group I claims 1, 2, 14, 20-25, 28-32, 37-42, 74, 75, and 79-82, or the

switching fabric recited in Group I claims 43-64. For these reasons, Groups I and II do not appear to be related as combination and subcombination, as alleged in the Office Action.¹

Second, part of the test set forth in MPEP § 806.05(c) involves determining whether the combination requires the particulars of the subcombination for patentability. If there is no such requirement, restriction is justified, whereas if there is such a requirement, restriction is not justified.

The Office Action states that the “the combination [(Group I)] as claimed does not require the particulars of the subcombination as claimed because managing cell data as associated with [a] plurality of framers is not needed for configuring components associated with a switch fabric.” However, this reasoning seems to be in terms of whether components can be configured physically, without a need to manage data associated with framers, - - not whether the Group I claims can be patentable over the prior art without the particulars of the Group II claims. In other words, to establish a valid restriction requirement, the Office Action should have admitted, at the very least, that the Group I claims are patentable over the prior art, even without the particulars of the Group II claims. However, the Office Action has made no such statement.

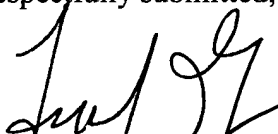
For all of the foregoing reasons, it is believed that the Office Action has failed to set forth a valid justification for the restriction requirement, and thus reconsideration and withdrawal of the restriction requirement are respectfully requested.

^{1/} If the Examiner believes otherwise, she is respectfully requested to explain how the apparatus coupled to plural cell framers, of Group II claims 33-36, can be a subcombination of a method such as that recited in Group I claims 3-13, 15-19, 26, 27, 65-73, and 76-78, and how that apparatus can also be a subcombination of the apparatus recited in Group I claims 1, 2, 14, 20-25, 28-32, 37-42, 74, 75, and 79-82, or switching fabric recited in Group I claims 43-64.

Favorable consideration on the merits and early passage to issue of the elected claims also are respectfully requested.

The undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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